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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,556	03/20/2001	Toshihiko Fukushima	501.39577X00	3910

20457 7590 02/08/2005

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EXAMINER

JARRETT, SCOTT L

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/811,556

Applicant(s)

FUKUSHIMA ET AL.

Examiner

Scott L. Jarrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-33 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 22 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because it is longer than 150 words.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 101

3. Claims 1, 10-11, 12-17, 18-21 and 23-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory

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subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Regarding Claims 1 and 23, Claims 1 and 23 only recites an abstract idea. The recited method of causing energy-saving facilities to be introduced into a customer and the collecting the costs of the energy-saving facility does not apply, involve, or use the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. The claimed invention, as a whole, is not within the technological art as explained above claims 1 and 23 are deemed to be directed to non-statutory subject matter.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation of the term "computing device" and "computing" in Claim 1. Therefore, the terms discussed are taken to merely recite a field of use and/or nominal recitation of technology.

Regarding Claims 10, 11, and 24-33, Claims 10, 11, and 24-33 do not utilize the proper computer program product format and effectively recite software per se (descriptive material). Claims 10, 11, and 24-33 are therefore deemed to be directed to non-statutory subject matter where there is no indication that the proposed software is

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recorded on computer-readable medium and/or capable of execution by a computer.

Examiner suggests that the applicant incorporate into Claims 10, 11, and 24-33 language that the proposed software is recorded on computer-readable medium and capable of execution by a computer to overcome this rejection.

Regarding Claims 12-21, Claims 12-21 only recite an abstract idea. The recited method collecting the costs of an energy saving facility installed into a customer does not apply, involve, or use the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. The claimed invention, as a whole, is not within the technological art as explained above claims 12-21 are deemed to be directed to non-statutory subject matter.

Correction required. See MPEP § 2106 [R-2].

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 6, 8, 10, 23-24 and 32 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Yabutani et al., U.S. Patent No. 6,775,595.

Regarding Claim 1, Yabutani et al. teach a method and system for causing energy-saving facilities to be introduced (installed, sold, leased, rented, etc.) into a customer and collecting (billing, charge processing) of the costs associated with the introduced energy-saving facilities, comprising the steps of (Abstract; Column 2, Lines 6-45; Column 3, Lines 19-31 and 55-68; Column 4, Lines 14-39; Column 5; Lines 22-65; Column 6, Lines 44-54; Column 7, Lines 1-42; Figures 1-2 and 7-8 as shown below):

- predicting the reduced amount of running costs (energy savings) over a period of time;
- capturing (inputting, collecting) the actual operating costs (status, usage, results) of the energy-saving facilities over a period of time;
- periodically calculating (computing, determining) the reduced amount of the running costs; and

- periodically collecting (billing, charge, merit refund) an amount based on the reduced amount of the running costs.

FIG. 8

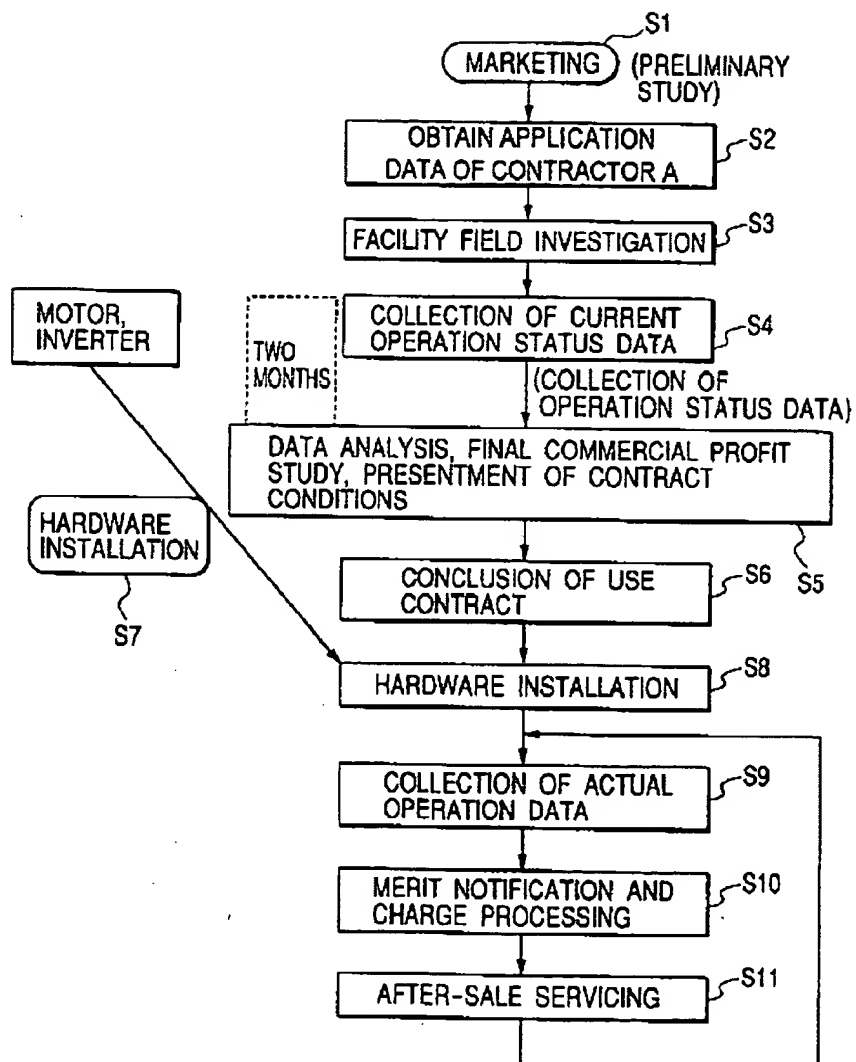


Figure 1: Yabutani et al. (Figure 8)

FIG. 1

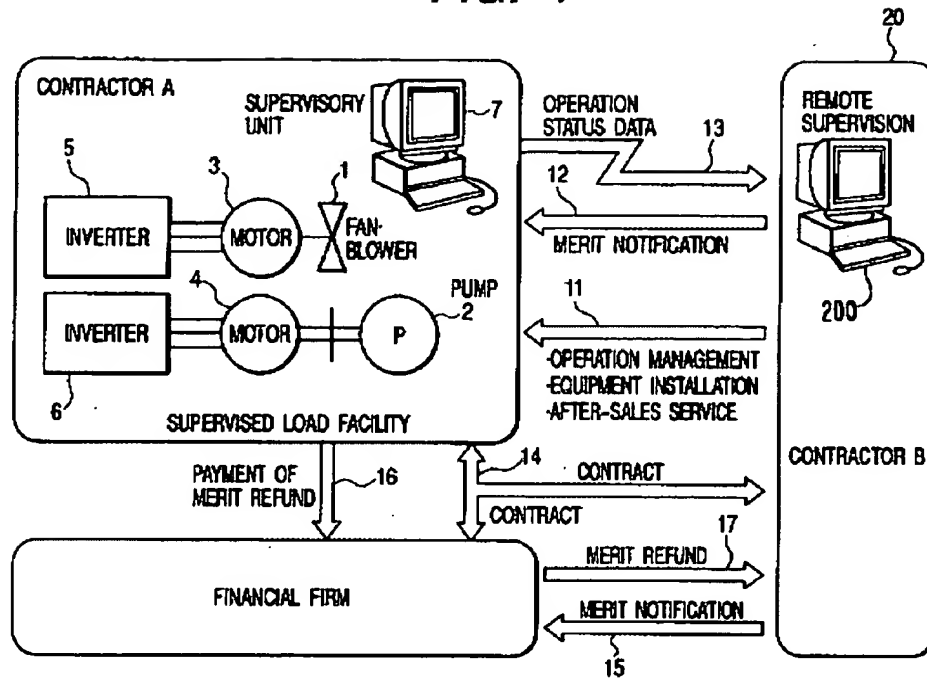


Figure 2: Yabutani et al. (Figure 1)

FIG. 2

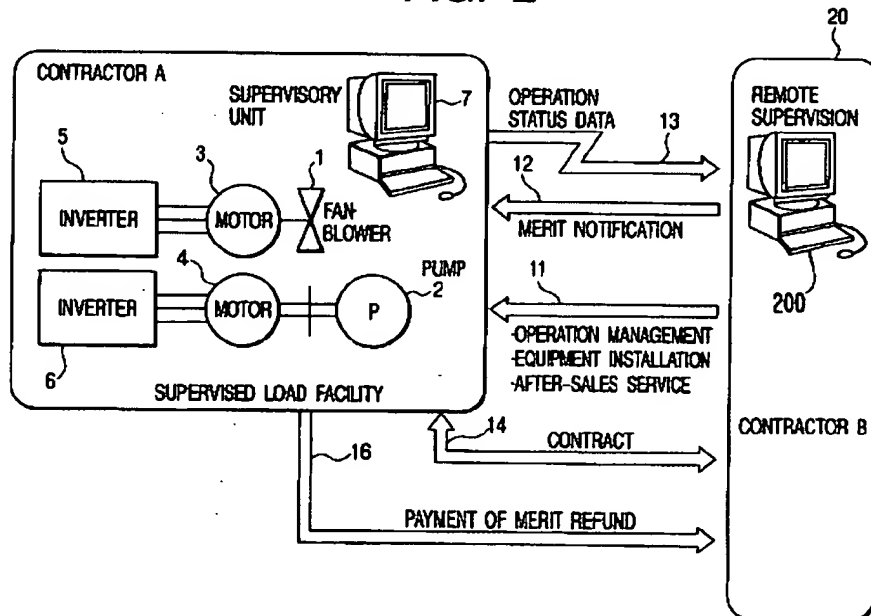


Figure 3: Yabutani et al. (Figure 2)

FIG. 4

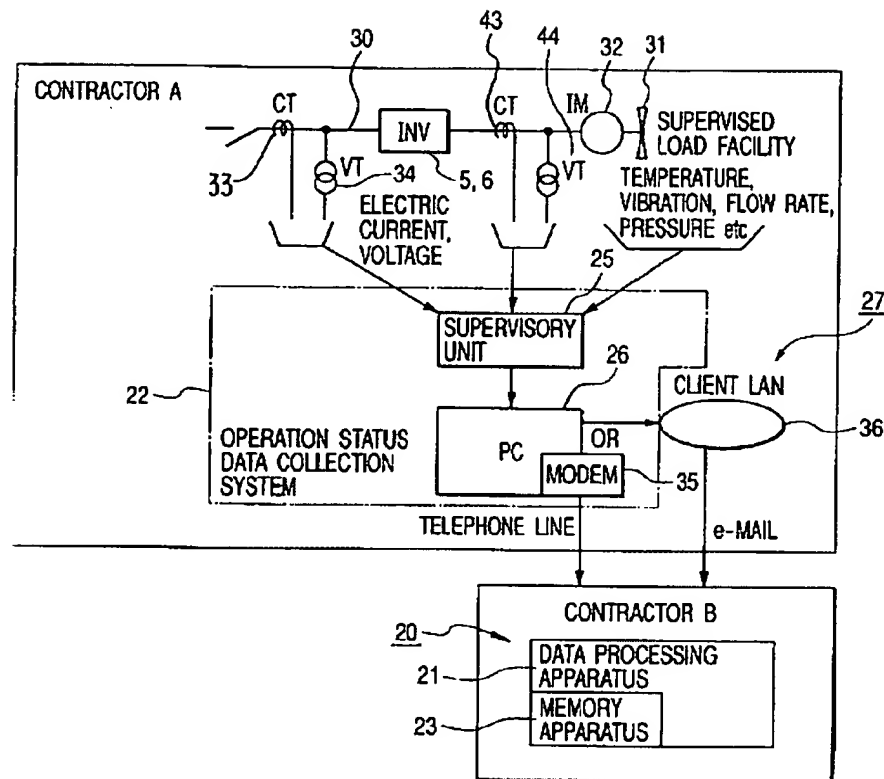


Figure 4: Yabutani et al. (Figure 4)

Regarding Claims 2 and 6 Yabutani et al. teach a system and method for collecting the costs of an energy-saving facility installed (introduced) to a customer, comprising (Abstract; Column 2, Lines 6-45; Column 3, Lines 19-31 and 55-68; Column 4, lines 14-39; Column 5; Lines 22-65; Figures 1-2 and 7-8):

- means for determining (calculating, estimating) and storing a predicted reduced amount of running costs (energy savings);
- means for monitoring the actual operation of the energy-saving facilities;

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- means for calculating a reduced amount of the running costs on the basis of the actual operation of the energy-saving facilities, the information obtained from a remote monitoring part (sensor, device, supervisory unit, data processing apparatus); and
- means for collecting (billing) from the customer an amount reflecting the reduced amount of the running costs (energy-savings).

Regarding Claim 3 Yabutani et al. teach a system for the collecting (billing, charge processing) the costs of energy-saving facilities comprising (Abstract; Column 2, Lines 6-45; Column 3, Lines 19-31 and 55-68; Column 4, lines 14-39; Column 5; Lines 22-65; Column 6, Lines 44-54; Column 7, Lines 1-42; Figures 1-2 and 7-8):

- collecting and storing operation data (actual) and the amount historical energy use of the customer;
- calculating a reduced amount of running cost from the operation data and the amount of energy use; and
- notifying a financial institution (firm) of data indicative of the reduced amount of the running costs to be drawn from an account of the customer and transferred to an account of the business (ESCO, contractor, etc.; Column 7, Lines 15-42; Figure 1, Elements 12 and 15).

Regarding Claim 8 Yabutani et al. teach that the energy services system further comprises a contract between the businesses (firms, entities, etc.) involved in the introduction of the energy saving facilities and that the contract conditions comprises a

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plurality of factors, charges, terms and details related to the introduction of the energy saving facilities into the customer (Column 3, Lines 5-49; Column 4, Lines 40-68; Column 6, Lines 1-0 and 40-55).

Regarding Claim 10 and 32 Yabutani et al. teach a system for causing energy-saving facilities to be introduced (installed) into a customer and collecting the costs of the energy-saving facilities, comprising (Abstract; Column 2, Lines 6-45; Column 3, Lines 19-31 and 55-68; Column 4, Lines 14-39; Column 5; Lines 22-65; Column 6, Lines 44-54; Column 7, Lines 1-42; Figures 1-2 and 7-8 as shown above):

- predictively computing (calculating, determining) the reduced amount of the running costs of the energy-saving facilities;
- the lease (rental) of the energy saving facilities (Column 1, Lines 50-68, Column 2, Lines 1-45; Column; Column 4, Lines 53-68);
- determination (calculation) of the lease charge (billing and charge processing);
- remote monitoring (collection, inputting) of actual operation status;
- determination (calculation) of the reduced amount (energy savings) of the running costs on the basis of actual operation status; and
- collecting from the customer an amount which reflects the reduced amount of the running costs.

Regarding Claim 23, 24 and 28 Yabutani et al. teach a system for causing energy-saving facilities to be introduced (installed) into a customer and collecting the

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costs of the energy-saving facilities, comprising (Abstract; Column 2, Lines 6-45; Column 3, Lines 19-31 and 55-68; Column 4, Lines 14-39; Column 5; Lines 22-65; Column 6, Lines 44-54; Column 7, Lines 1-42; Figures 1-2 and 7-8 as shown above):

- predicting (calculating, estimating, determining) the reduced amount of the running costs of the energy-saving facilities based on the existing facilities of the customer;
- the sale (selling, contract, after-sale services) of the energy saving facilities at a selling price that reflects the reduced amount of running costs (energy savings);
- remote monitoring (collection, inputting) of actual operation status into a storage device;
- periodically computing (determining, calculating) the reduced amount (energy savings) of the running costs on the basis of actual operation status; and
- periodically collecting from the customer an amount which reflects the reduced amount of the running costs.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 4, 5, 9, 11 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yabutani et al., U.S. Patent No. 6,775,595 as applied to claims 1-3, 6, 8, 10, 23-24, 28 and 32 above.

Regarding Claim 4 and 5 Yabutani et al. teach an energy services system wherein the customer is notified of the amount to be withdrawn from the account (Column 7, Lines 15-42; Abstract; Column 2, Lines 6-45; Column 3, Lines 19-31 and 55-68; Column 4, Lines 14-39; Column 5; Lines 22-65; Column 6, Lines 44-54; Column 7, Lines 1-42; Figures 1-2 and 7-8 as shown above).

Yabutani et al. does not expressly teach that the notification includes the repayment balance or a notification indicative of the completion of repayment.

Official notice is taken that it is old and very well known in the art of financial services include the a plurality of information including but not limited to the remaining balance to be paid on a loan, lease or other installment payment as part of a bill (contract, agreement, notification, coupon book, or the like) and/or an indication that the

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loan has been repaid in full thereby clearly communicating to the customer the current status of the account.

It would have been obvious to one skilled in the art at the time of the invention that the energy services system as taught by Yabutani et al. would have included as part of its customer notification (bill) a plurality of information commonly found on such bills (notifications, communications) including but not limited to information related to the status of the loan (agreement, contract, rental, etc.; repayment balance, remaining balance, loan repaid, etc.) and in doing so clearly communicating to the customer the current status of the account.

Regarding Claim 9 Yabutani et al. teach an energy services system further comprises a means for notifying the customer through the use of a computer, having a modem and being connected to a network, with electronic mail capabilities (Figure 3; Column 5, Lines 53-64; Column 6, Lines 1-5; Column 8, Lines 20-30).

Yabutani et al. does not expressly teach that the network is the Internet.

Official notice is taken that a computer, having a modem and being connected to a network, with electronic mail capabilities is more than capable of utilizing the Internet and further would have more than likely utilized the Internet (public network) as a means for connecting (communicating) between the plurality of systems, sensors and entities

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involved in the energy services system and that electronic mail (email, e-mail) can be defined as the exchange of messages between users who have access to either the same system or who are connected via a network (often the Internet).

It would have been obvious to one skilled in the art at the time of the invention that the energy services system as taught by Yabutani et al. would have utilized the Internet (network) for facilitating the system's connectivity with the plurality of remote sensors, systems and other entities thereby providing a readily available and efficient means for communications.

Regarding 11 and 33 Yabutani et al. teach that the energy services system further comprises a contract between the businesses (firms, entities, etc.) involved in the introduction of the energy saving facilities and that the contract conditions comprises a plurality of factors, charges, terms and details related to the introduction of the energy saving facilities into the customer (Column 3, Lines 5-49; Column 4, Lines 40-68; Column 6, Lines 1-0 and 40-55).

Yabutani et al. does not expressly teach that collections from the customer include a flat-rate energy charge.

Official notice is taken that flat-rate (fixed) energy charges are well known and in the utilities industry.

It would have been obvious to one skilled in the art at the time of the invention that the energy services system as taught by Yabutani et al. would have included a plurality of common charges (fees, taxes, etc.) as part of the normal course of doing business in the energy services market.

8. Claims 12-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yabutani et al., U.S. Patent No. 6,775,595 as applied to claims 1-3, 6, 8, 10, 23-24, 28 and 32 above and further in view of Packa et al., U. S. Patent No. 5,717,609.

Regarding Claim 12, 13, 18, 19 and 22 Yabutani et al. teach a system for (Abstract; Column 2, Lines 6-45; Column 3, Lines 19-31 and 55-68; Column 4, Lines 14-39; Column 5, Lines 22-65; Column 6, Lines 44-54; Column 7, Lines 1-42; Figures 1-2 and 7-8 as shown above):

- collecting, measuring and storing actual operation status of the energy-saving facility;
- calculating a reduced amount of the energy cost (energy savings);
- deciding (determining, calculating) an amount to be drawn from the customer account based on the reduced amount of the running costs and a predicted reduced amount of the energy-saving facility; and
- arranging the withdrawing of the amount based on the energy savings from the customer account.

Yabutani et al. does not teach that energy savings are based on a comparison between non-energy saving and energy saving facilities.

Packa et al. teach a system for causing the introduction of energy saving facilities into a customer wherein the energy savings are based (calculated, determined) on a comparison between non-energy saving and energy saving facilities (Abstract; Figures 4 and 8 as shown below).

Packa et al. further teach an energy services system comprising (Abstract; Column 1, Lines 6-40; Column 2, Lines 61-68; Column 3, Lines 35-68; Column 4, lines 1-33; Column 11, Lines 16-40; Column 12, Lines 49-68; Column 13, Lines 13-26 and 45-58; Figures 2 and 5-8):

- the measurement and verification of energy savings and reduction in operating costs;
- periodically (any time, real-time) remotely collecting (inputting, monitoring), storing and analyzing operational data over a network;
- determining (calculating) energy savings based on the actual and projected energy savings resulting from the introduction of energy saving facilities at a customer; and
- energy savings as the basis for a shared savings (performance contracting, demand side management, rebate program, etc.) arrangement between a business and the customer.

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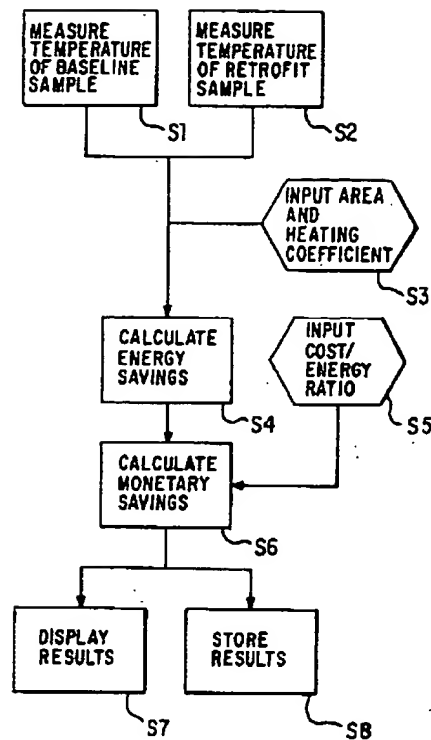


FIG. 4

Figure 5: Packa et al. (Figure 4)

The screenshot shows a software window titled 'EMVS Demo'. It contains two main sections: 'Input parameters' and 'Output data'. The 'Input parameters' section has three rows, each with a label, a text input field, and a unit: 'Heat Transfer Coefficient' (1.46 BTU/hr-ft²-°F), 'Area of Window Film' (50 ft²), and 'Cost of Energy' (0.025 \$/BTU). The 'Output data' section has five rows, each with a label and a numerical value: 'Baseline Temperature (#1)' (84.20 °F), 'Retrofit Temperature (#2)' (75.50 °F), 'Temperature Difference' (8.71 °F), 'Heat Savings per hour' (635.54 BTU/hr), and 'Cost Savings per hour' (15.89 \$/hr). At the bottom of the window are three buttons: 'Log File...', 'Stop', and 'Advanced...'.

Input parameters	
Heat Transfer Coefficient	1.46 BTU/hr-ft ² -°F
Area of Window Film	50 ft ²
Cost of Energy	0.025 \$/BTU

Output data	
Baseline Temperature (#1)	84.20 °F
Retrofit Temperature (#2)	75.50 °F
Temperature Difference	8.71 °F
Heat Savings per hour	635.54 BTU/hr
Cost Savings per hour	15.89 \$/hr

Log File... Stop Advanced...

FIG. 8

Figure 6: Packa et al. (Figure 8)

It would have been obvious to one skilled in the art at the time of the invention that the energy services system as taught by Yabutani et al. would have benefited from the additional measurement and verification capabilities in view of the teachings of Packa et al. the resultant system being capable of providing more robust calculations of the reduction in running costs.

Regarding Claim 14-15 and 20-21 Yabutani et al. teach an energy services system that measures the amount of energy used throughout the day (Figure 7 as shown below) and the running costs (energy savings) are calculated throughout the day.

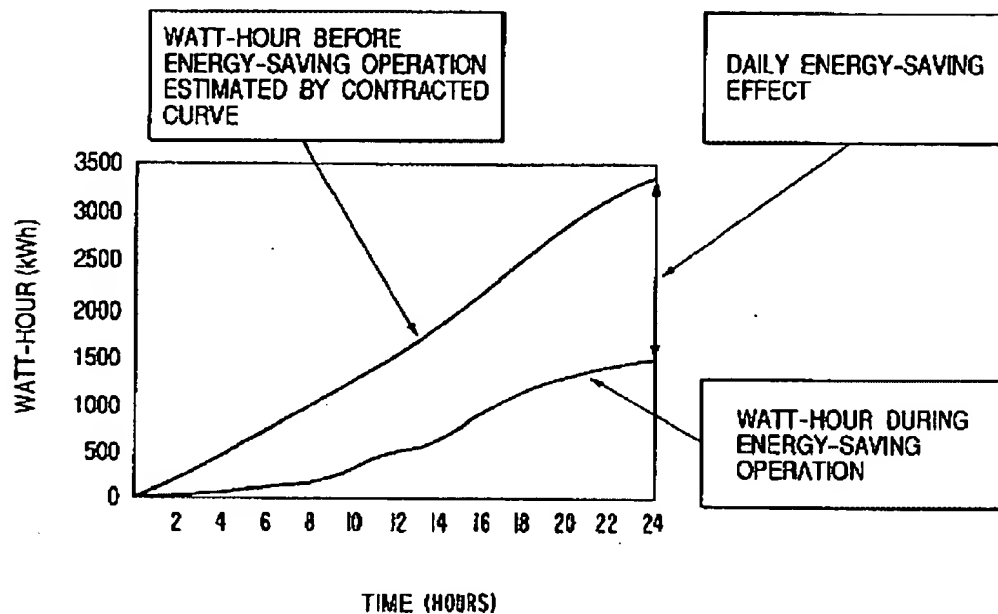
Yabutani et al. does not expressly teach that the rate charged for energy usage varies throughout the day.

Official notice is taken that it is old and very well known for utilities to charge different rates to different customers based on a plurality of factors including the time of day.

It would have been obvious to one skilled in the art at the time of the invention that the energy services system as taught by Yabutani et al. would have implicitly applied the rate or rate(s) charged by the energy providing utility (resource, company)

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as part of its calculations of the reduced running costs (energy savings) thereby providing a more accurate determination of the reduction in running costs.

FIG. 7**Figure 7: Yabutani et al. (Figure 7)**

Regarding Claims 16 and 17 Yabutani et al. teach that the energy services system further comprises a contract between the businesses (firms, entities, etc.) involved in the introduction of the energy saving facilities and that the contract conditions comprises a plurality of factors, charges, terms and details related to the introduction of the energy saving facilities into the customer including but not limited to energy charges, operation management and after sales services (maintenance; Column 3, Lines 5-49; Column 4, Lines 40-68; Column 6, Lines 1-0 and 40-55).

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9. Claims 7, 25-27, and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yabutani et al., U.S. Patent No. 6,775,595 as applied to claims 1-3, 6, 8, 10, 23-24, 28 and 32 above and further in view of Johnson, Jerome D., U.S. Patent No. 5,758,331.

Regarding Claim 7 and 29 Yabutani et al. teach an energy services system wherein a plurality of energy saving alternatives (facilities) are considered.

Yabutani et al. does not expressly teach a plurality of representative operation patterns (usage patterns, profiles, solutions, energy-saving options, conservation programs, etc.) or the selection of such a pattern.

Johnson teaches a system for causing the introduction of energy-saving facilities to be introduced into a customer wherein (Column 1, Lines 65-68; Column 2, Lines 1-11 and 35-68; Column 3, Lines 1-36):

- the customer is presented with a plurality of representative operation patterns (conservation programs, products and services, recommendations, usage patterns, rate structures; Column 4, Lines 57-68; Column 14, Lines 8-11; Column 17, Lines 1-30; Column 21, Lines 7-25; Column 26, Lines 8-40);

- a means for selecting from amongst the representative operation patterns according to the scale (size, type, location, number, etc.) of the facilities (Customer Information Module, Column 9, Lines 15-68; Figure 1, Element 12); and

- means for calculating (determining) the reduced operation costs (energy savings).

Johnson further teaches that the energy services system comprises a plurality of modules including but not limited to inventory, conservation programs, finance, proposal, customer information and reports (Column 4, Lines 49-68; Column 5, Lines 1-47; Column 9, Lines 15-68; Column 16, Lines 25-29; Column 18, Lines 10-14 and 24-68; Column 20, Lines 19-68; Table 1, Columns 5-6).

FIG. 1

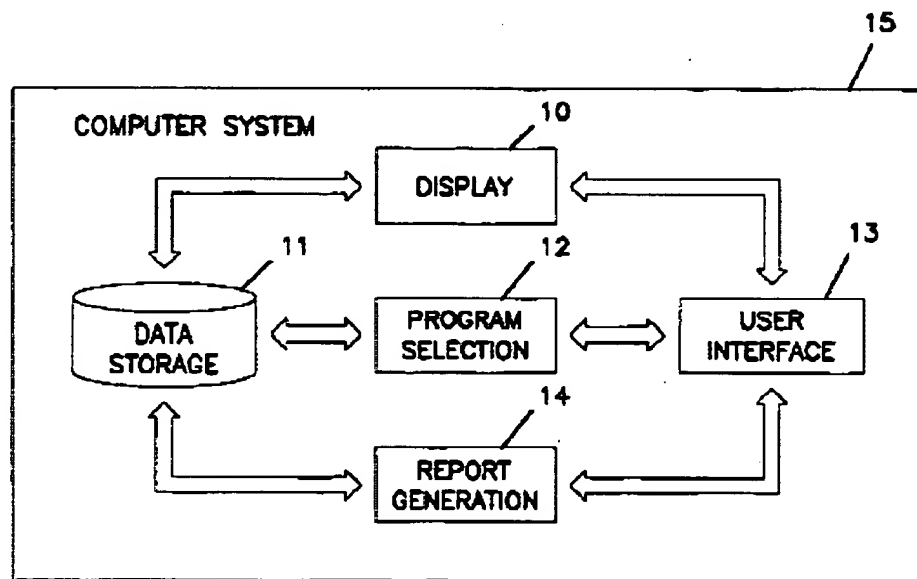


Figure 8: Johnson (Figure 1)

It would have been obvious to one skilled in the art at the time of the invention that the energy services system as taught by Yabutani et al. would have benefited from the ability to present a plurality of representative operation patterns to a customer the

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resultant system providing a larger number of energy saving options (patterns, solutions, alternatives) from which the customer could select.

Regarding Claim 25 Yabutani et al. teach a system for collecting the costs of energy saving facilities, comprising (Abstract; Column 2, Lines 6-45; Column 3, Lines 19-31 and 55-68; Column 4, Lines 14-39; Column 5; Lines 22-65; Column 6, Lines 44-54; Column 7, Lines 1-42; Figures 1-2 and 7-8 as shown above):

- collection (capturing, inputting) and storage of operation data and energy usage as historical information;
- a business (business enterpriser, firm, contractor) that acquires (receives) via a communication means (network) the collected customer data;
- calculation (determining) the reduced amount of running costs (energy savings) of the facilities from the customer data; and
- notifying a financial institution (firm) via a communication channel (network) data indicative of the amount of the running cost in order to cause the amount to be drawn from the account of the customer and transferred to the account of the business enterpriser (firm, business, contractor).

Yabutani et al. teach the storage of a plurality of data in a memory-apparatus however Yabutani et al. does not expressly teach that the memory-apparatus is a database.

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Johnson teaches an energy services system wherein data is stored in database (Figure 1 as shown above; Column 3, Lines 40-68; Column 4, Lines 1-6)

It would have been obvious to one skilled in the art at the time of the invention that the energy services system as taught by Yabutani et al. would have benefited from storing a plurality of information in a database in view of the teachings of Johnson the resultant system providing a more robust data storage, retrieval and reporting capabilities.

Regarding Claim 26 and 27 Yabutani et al. teach an energy services system wherein the customer is notified of the amount to be withdrawn from the account (charge, charge and bill collective services; Column 7, Lines 15-42) and that the customer is notified through the use of a computer, having a modem and being connected to a network, with electronic mail capabilities (Figure 3; Column 5, Lines 53-64; Column 6, Lines 1-5; Column 8, Lines 20-30).

Yabutani et al. does not expressly teach that the notification includes the balance of repayment, completion of repayment or that the notification is delivered via the Internet.

Official notice is taken that it is old and very well known in the art of charge processing (financial services) to include the a plurality of information including but not

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limited to the remaining balance to be paid on a loan, lease or other installment payment as part of a bill (contract, agreement, notification, coupon book, or the like) and/or an indication that the loan has been repaid in full thereby clearly communicating to the customer the current status of the account.

It would have been obvious to one skilled in the art at the time of the invention that the energy services system as taught by Yabutani et al. would have included as part of its customer notification (bill) information related to the repayment balance (remaining balance, load repaid, etc.) and in doing so clearly communicating to the customer the current status of the account.

Official notice is taken that a computer, having a modem and being connected to a network, with electronic mail capabilities is more than capable of utilizing the Internet and further would have more than likely utilized the Internet (public network) as a means for connecting (communicating) between the plurality of systems, sensors and entities involved in the energy services system and further that electronic mail (email, e-mail) can be defined as the exchange of messages between users who have access to either the same system or who are connected via a network (often the Internet).

It would have been obvious to one skilled in the art at the time of the invention that the energy services system as taught by Yabutani et al. would have utilized the Internet (public network) for facilitating the systems connectivity with the plurality of

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remote sensors, systems and other entities thereby providing a readily available and very efficient communications.

Regarding Claim 30 Yabutani et al. teach that the energy services system further comprises a contract between the businesses (firms, entities, etc.) involved in the introduction of the energy saving facilities and that the contract conditions comprises a plurality of factors, charges, terms and details related to the introduction of the energy saving facilities into the customer (Column 3, Lines 5-49; Column 4, Lines 40-68; Column 6, Lines 1-0 and 40-55) some of the conditions specific related to the financial obligations agreed upon.

Regarding Claim 31 Yabutani et al. teach an energy services system that remotely measures the amount of the running cost reduction (energy savings) and notifies the customer regarding the energy savings as discussed above.

Yabutani et al. does not expressly teach that the notification is by means of the Internet.

Official notice is taken that a computer, having a modem and being connected to a network, with electronic mail capabilities is more than capable of utilizing the Internet and further would have more than likely utilized the Internet (public network) as a means for connecting (communicating) between the plurality of systems, sensors and entities

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involved in the energy services system and further that electronic mail (email, e-mail) can be defined as the exchange of messages between users who have access to either the same system or who are connected via a network (often the Internet).

It would have been obvious to one skilled in the art at the time of the invention that the energy services system as taught by Yabutani et al. would have utilized the Internet (public network) for facilitating the communication between the plurality of entities involved in the system thereby providing a readily available and efficient means for communicating.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references applied to the claims for the convenience of the applicant. Although the specific citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Anderson, Milton, U.S. Patent No. 5,283,829, teaches a system for paying bills electronically, including but not limited to utility bills. Anderson further teaches that the bills can be automatically paid via automatic funds transfer.

- Crooks et al., U.S. Patent No. 6,088,688, teach a system for utility resource management wherein energy consumption is managed, tracked and reported on. Crooks et al. further teach that the system monitors (identifies, collects) and calculates running cost reductions (cost savings, actual usage) from remote locations.

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- Gaus et al., U.S. Patent No. 6,343,277, teach an energy network commerce system wherein energy usage patterns are captured, stored and used to assist in the negotiation of energy savings.

- Zaloom, Joseph A., U.S. Patent No. 6,366,889, teaches a system for causing energy saving facilities (measures, equipment, retrofit, etc.) to be introduced into a customer and the billing (collecting of costs) of the energy-saving facilities comprising the prediction of energy savings, including the use of energy saving scenarios, the analysis of the energy consumption of the customer and periodically billing the customer.

- Collins et al., U.S. Patent No. 6,553,418, teach an energy information and control system wherein real-time and historical energy consumption information (data) is collected remotely, stored and analyzed.

- Justen, Jonathan, U.S. Patent No. 6,701,298, teaches a system for energy performance evaluation and improvement.

- Smith et al., U.S. Patent No. 6,795,592, teach an energy savings and management system wherein energy usage information is collected, stored and analyzed using predictive modeling techniques to determine energy saving opportunities. Smith et al. further teach that the system can simulate energy consumption using baseline operational data, propose optimal operation conditions as well as measure and determine actual energy savings. Smith et al. further teach that they system provides bill payment capabilities.

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- Sick et al., U.S. Patent Publication No. 2003/0216971, teach a resource management system wherein energy consumption information is collected and analyzed in order to determine energy usage patterns (energy profile, time slices, time-of-use, historical, etc.) and the customer's energy requirements which are then used as the basis for energy saving proposals (negotiations) between suppliers and buyers. Sick et al. further teach that the system utilizes the Internet and can generate a utility bill.

- Ratteree et al., U.S. Patent Publication No. 2002/0010563, teach a method and system for causing energy saving (resource saving) facilities (practices, equipment, etc.) to be introduced into a customer comprising the use of performance based contracting (shared savings) that enable the customer to finance the energy saving project (capital improvements). Ratteree et al., further teach that the repayment of the energy saving facilities can be accomplished in a plurality of ways including but not limited to payments based on the energy savings, being calculated by comparing the actual energy use with the predicted energy use.

- Donahue, Patricia, Energy Performance Contracting – A new tool for financing energy-efficiency projects, teach the method of energy performance contracting. Donahue further teaches that energy performance contracting comprises the steps of an energy audit, energy saving recommendations based on the audit (recommendations that will generate enough energy and cost savings to pay for the project), financing of the project by the business partner (ESCO; leasing being the most common financing option), installation of the energy saving facilities, monitoring and verifying the energy

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savings (comparing projected to actual savings), provides ongoing maintenance, training and other services.

- Goldman et al., Historical Performance of the U.S. ESCO Industry: Results from the NAESCO Project Database, teaches the prevalence of energy services companies and that of the approximately 800 project analyzed over 90% of the projects were based on some form of performance based contracting.

- NAESCO.org – About and Bookstore Internet pages, teach the old and very well known National Association of Energy Services Companies. The site further teaches that NAESCO members provide a plurality of services including but not limited to: energy consumption reduction, financing and measurement and verification of energy consumption and efficiency.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Jarrett whose telephone number is (703) 306-5679. The examiner can normally be reached on Monday-Friday, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hafiz Tariq can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SJ
2/4/2005

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